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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,226	09/02/2004	Burton G. Goldstein	1372.189.PRC	5225
21901	7590	04/17/2007		
SMITH HOPEN, PA 180 PINE AVENUE NORTH OLDSMAR, FL 34677			EXAMINER LANG, AMY T	
			ART UNIT	PAPER NUMBER
			3731	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/17/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/711,226

Applicant(s)

GOLDSTEIN, BURTON G.

Examiner

Amy T. Lang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 2-4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 2/5/2007. In particular, claims 1, and 5-8. This combination of limitations was not present in the original claims. Thus, the following action is properly made final.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 1, 5, and 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mercereau (US 6,652,537 B2).

With regard to **claim 1**, Mercereau discloses a retrieval device for capturing and removing objects (column 1, lines 33-35). Although Mercereau does not specifically disclose the device as removing intraocular foreign bodies as instantly claimed, this limitation is merely an intended use phrase and is therefore given no patentable weight. The examiner's position is supported by case law, which holds that "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation." *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) and MPEP 2111.02.

The device of Mercereau comprises, as shown in Figures 1 and 19, an elongate base (12 and 14) comprising an elongate bore (bottom edge of 14) that distally terminate in open communication with each other. A foreign body capturing means (16) is slideably received in the bore through tubes (64 and 66) (column 5, lines 24-37). As shown in Figure 21, the foreign body capturing means comprises an elongate handle, a rim (172) and a net comprised of legs (170a-170d) (column 7, lines 8-11, 55-59). A control member (18) is slideably connected to the capturing means for adjusting the position of the net (column 6, lines 1-12). As shown in Figures 16 and 17, the fully retracted and extended position of the control member (18) corresponds to the fully retracted and extended position of the foreign body capturing means (16). An infinite number of positions exist between the fully retracted and extended positions (column 10, lines 38-40). When the foreign body capturing means is fully retracted, it is received within the elongate bore (Figure 16).

A longitudinal slot (26) is formed in the elongate base (12) and parallel to the elongate bore (Figure 3, column 4, lines 30-42). It is the examiner's position that the slot is substantially equal to the length of the bore since the instant application does not further define "substantially." A rod (42) extends through the elongate slot (26) and connects the control member (46) to the foreign body capturing means (Figures 3, 4, and 12-14). Although Mercereau does not specifically disclose the slot as comprising a width less than the width of the bore, it would have been obvious since such a modification would involve a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art (*In Re Rose*, 105 USPQ 237 (CCPA 1955)).

Mercereau further discloses a truncated slot (30) formed in the bottom wall of the elongate base (Figure 4, column 4, lines 40-42). Although Mercereau does not specifically disclose the slot (30) as comprising a leading end in open communication with the leading end of the elongate base, it would have been an obvious matter of design choice. The instant disclosure describes this parameter as merely preferable and does not describe it as contributing any unexpected result to the device. As such this parameter is deemed a matter of design choice (lacking in any criticality) and well within the skill of the ordinary artisan, obtained through routine experimentation in determining optimum results. Therefore, the truncated slot would support the rim of the net. Furthermore, although Mercereau does not specifically disclose the size of the truncated slot as shorter than the elongate bore and wider than the elongated slot, it would have been obvious since such a modification would involve a mere change in the size of

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a component. A change in size is generally recognized as being within the level of ordinary skill in the art (*In Re Rose*, 105 USPQ 237 (CCPA 1955)).

The net, disclosed by Mercereau comprises an upper end (172) mounted about the perimeter of the rim (Figure 21). Although Mercereau does not specifically disclose the net, when fully retracted as extending below the bottom wall of the elongate base, since the net is contained within the elongate base, it would have been obvious to one of ordinary skill at the time of the invention for the net to extend below the base.

With regard to **claim 5**, as shown in Figure 21, the net comprises two branches, each having a first and second arcuate curve. The second arcuate curves converge at point (180) to form a rim. The rim is linear when retracted within the bore and elliptical when extended (Figures 16 and 21).

With regard to **claim 6**, the rim is further disclosed as Nitinol, which overlaps the instantly claimed metallic material (column 6, lines 8-12).

4. **Claims 7 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mercereau (US 6,652,537 B2) in view of Sabet (US 2003/0135221 A1).

Mercereau discloses a device for capturing and removing objects from the body. The device comprises an elongate base and distal net. However, Mercereau does not specifically disclose the net as formed of a fabric mesh or the rim of the net comprising a polymeric material.

Sabet also discloses a device for removing objects from a body comprising an elongate base and a net (Figure 7, [0021]). The net is comprised of a mesh or netting

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material and the rim as a biocompatible material, which encompasses a polymeric material ([0036]). Therefore, since Sabet teaches a device to remove objects from the body comprising a mesh net and polymeric rim, it would have been obvious to one of ordinary skill at the time of the invention for the net of Mercereau to also comprise a mesh net and polymeric rim.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy Lang whose telephone number is (571) 272-9057. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

4/10/2007  
Amy T. Lang  
ATL

  
**ANH TUAN T. NGUYEN**  
**SUPERVISORY PATENT EXAMINER**  
4/14/07